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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,718	10/23/2000	James D. Bennett	YO998-100RA	2739

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EXAMINER
FUREMAN, JARED

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/695,718	BENNETT, JAMES D.
	Examiner	Art Unit
	Jared J. Fureman	2876

-- The MAILING DATE of this communication appears on the cover sheet with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *51-77* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *51-59,62-71,74 and 75* is/are rejected.

7)☒ Claim(s) *60,61,72 and 73* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 October 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Receipt is acknowledged of the petition to revive, amendment, and terminal disclaimer, filed on 2/25/2003, which have been entered in the file. The petition to revive has been granted (see paper number 13). Claims 51-77 are pending.

2. The indicated allowability of claims 51-57 is withdrawn in view of the newly discovered reference(s) to Watanabe et al (US 5,557,096). Rejections based on the newly cited reference(s) follow.

Terminal Disclaimer

3. The terminal disclaimer filed on 2/25/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5,056,199 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

4. Claim 75 is objected to because of the following informalities: Claim 75, lines 3-10: "the goods" lacks proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 74 and 75 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al (US 5,557,096).

Watanabe et al teaches a device (writing machine 18, bar-code reader 21, and computer 22) that reads a plurality of information tags, the device comprising: an antenna (the writing machine 18 uses a radio-wave technique, see column 7 lines 40-46, thus, an antenna is necessarily present with the writing machine 18); a first processing circuit (reading and processing circuitry associated with bar-code reader 21) that generates first information (an identification number, represented by bar-code 15) from a first information tag (the bar-code 15); and a second processing circuit (processing circuitry associated with the writing machine 18), coupled to the antenna, that utilizes the first information to communicate with a second information tag (the writing machine 18 writes the identification number and variable data into RAM 29 of a responding circuit 4, the responding circuit 4 being a second information tag), wherein the second information tag is of a different type than the first information tag (the second information tag is an electronic responding circuit, whereas the first information tag is an optical bar-code), and stores more detailed information that the first information tag (the responding circuit stores the identification number as well as variable information, whereas the first information tag only stores the identification number); wherein the second information tag stores a plurality of data sets, the data sets including a source of goods (the sender of the parcel, see column 1 lines 58-62), and a destination of goods (the destination of the parcel, see column 1 lines 58-62) (see figures 7, 8, column 7 lines 25-46, column 10 line 17 - column 11 line 11).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 51-58, 62-66, 68-71, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al.

Re claims 51-54, 57, 58, 62-66, 68-71, 76 and 77: The teachings of Watanabe et al have been discussed above. Watanabe et al also teaches an identification system for goods stored by a carrier unit and a method for communicating between a reader device and a carrier unit, comprising: a temporary carrier unit (a parcel, for example) for storing articles of commerce; a plurality of goods (the contents of the parcel, for example) stored on the carrier unit, a first information tag (bar-code 15, of slip 1) disposed on the carrier unit (the slip 1 is attached to the parcel), a second information tag (responding circuit 4, of slip 1) disposed on the carrier unit, wherein the second information tag is of a different type than the first information tag (the second information tag is an electronic responding circuit, whereas the first information tag is an optical bar-code); and a device (writing machine 18, bar-code reader 21, and computer 22) that reads the first information tag and writes to the second information tag, the device comprising: an antenna (the writing machine 18 uses a radio-wave technique, see column 7 lines 40-46, thus, an antenna is necessarily present with the writing machine 18); a first processing circuit (reading and processing circuitry associated with

bar-code reader 21) that generates information (an identification number, represented by bar-code 15) from the first information tag (the bar-code 15); a second processing circuit (processing circuitry associated with the writing machine 18), coupled to the antenna, that utilizes the information to communicate with the second information tag (the writing machine 18 writes the identification number and variable data into RAM 29 of a responding circuit 4, the responding circuit 4 being a second information tag), the second information tag having relatively more detailed/less limited information in comparison to the first information tag (the responding circuit stores the identification number as well as variable information, whereas the first information tag only stores the identification number); wherein the second information tag stores a plurality of data sets, each data set being associated with the goods with which the second information tag is associated, the data sets including a source of goods (the sender of the parcel, see column 1 lines 58-62), and a destination of goods (the destination of the parcel, see column 1 lines 58-62); wherein the second information comprises identification data corresponding to the goods associated with the second information tag (the identification number stored in the second information tag can be considered as identification data corresponding to the goods, since the slip is attached to the parcel/goods); wherein the second information comprises identification data (the sender and destination of the parcel/goods, for example) corresponding to the goods associated with the second information tag, and the first information relates to a carrier for the goods (the first information, the identification data, relates to a carrier for the goods in that the identification data identifies the slip attached to the parcel/goods);

wherein the second information comprises location data for the goods associated with the second information tag (for example, the destination represents location data for the parcel/goods to which the second information tag/slip is attached); wherein the first information tag is an optical target (bar-code 15), the second tag is a radio tag (responding circuit 4), and the reader device reads the information from an image of the first information tag (the bar-code reading represents reading the information from an image of the bar-code); wherein the status information comprises status information (the variable data represents status information) for the plurality of goods; the step of communicating with the second information tag via a base station (writing to the second tag can be considered communicating with the second tag, and the writing machine 18 can be considered a base station) (see figures 7, 8, column 7 lines 25-46, column 10 line 17 - column 11 line 11).

Watanabe et al fails to specifically teach the device reading the second information tag and receiving from the second information tag via the antenna more detailed/less limited/status information than the first information, with respect to the given goods with which the second information tag is associated.

However, Watanabe et al also teaches a different embodiment wherein a device (computer 331 and interrogator 335) writes data (variable data) to an information tag (responding circuit 347 of slip 337) and then reads the data from the information tag, thereby receiving from the second information tag via an antenna (an antenna is necessarily present with the interrogator 335) more detailed/less limited/status information (the variable data), with respect to the given goods with which the

information tag is associated, in order to verify the written data (see figure 57 and column 33 lines 29-67).

In view of Watanabe et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Watanabe et al, the device reading the second information tag and receiving from the second information tag via the antenna more detailed/less limited/status information than the first information, with respect to the given goods with which the second information tag is associated, in order to verify correct writing of the data, thereby preventing errors during parcel shipping.

Re claim 55: The teachings of Watanabe et al have been discussed above.

Watanabe et al fails to specifically teach transmitting new status information from the reader unit to the second information tag; and storing the new status information on the second information tag.

However, Watanabe et al also teaches a different embodiment wherein new status information is transmitted from a reader unit (124) to a second information tag (the responding circuit of slip 120); and storing the new status information on the second information tag (see figure 25 and column 18 lines 55-65).

In view of Watanabe et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system and method as taught by Watanabe et al, transmitting new status information from the reader unit to the second information tag; and storing the new status information on the

second information tag, in order to provide the ability to update the status information as the slip is transported.

Re claim 56: The teachings of Watanabe et al have been discussed above.

Watanabe et al fails to specifically teach the step of transmitting from the second information tag to the reader device at least one location detection signal for geographically locating the carrier unit.

However, Watanabe et al also teaches a different embodiment wherein a reader device receives a location detection signal from the second information tag for geographically locating the carrier unit (for example, the delivery information is read and transmitted to a central office 101, in order to keep track of the location of the parcel in a real-time manner (see column 20 lines 1-18).

In view of Watanabe et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system and method as taught by Watanabe et al, the step of transmitting from the second information tag to the reader device at least one location detection signal for geographically locating the carrier unit, in order to provide the ability keep track of the parcels in a real-time manner.

9. Claims 59 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al in view of Johnsen (US 5,151,684).

The teachings of Watanabe et al have been discussed above.

Watanabe et al fails to specifically teach the device further including a selector that, depending upon a setting, individually enables or disables the first processing circuit and the second processing circuit.

Johnsen teaches a device (read/write scanner 50) for reading information from first (a bar code) and second information tags (tag device 10), the device comprising: an antenna (aerial 62); a first processing circuit (bar code reading circuit) that generates first information from a first information tag; and a second processing circuit (RF read/write circuit), coupled to the antenna, that communicates with a second information tag (RF tag); wherein the device further including a selector that (button "S" 54, button "R" 56, and trigger 64), depending upon a setting, individually enables or disables the first processing circuit and the second processing circuit (see figure 3 and column 6 line 67 - column 7 line 29).

In view of Johnsen's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Watanabe et al, the device further including a selector that, depending upon a setting, individually enables or disables the first processing circuit and the second processing circuit, in order to provide the operator more control over reading/writing to the information tags.

Allowable Subject Matter

10. Claims 60, 61, 72, and 73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken alone or in combination, fails to teach or fairly suggest: the reader having a mode of operation where the reader first performs a read operation with respect to the second information tag via the antenna, and then performs a read operation with respect to the first information tag; the reader having a mode of operation where the reader concurrently performs a read operation with respect to the second information tag via the antenna, and a read operation with respect to the first information tag; in combination with the other claimed limitations as set forth in the claims.

While Watanabe et al teaches a slip 1 with a first information tag (bar-code 15) and a second information tag (responding circuit 4), Watanabe et al teaches using the bar-code 15 for ordinary slip processing (for use without a responding circuit 4, see column 9 lines 41-45) or using the bar-code 15 to acquire an identification code which is written into the responding circuit 4 (see column 10 lines 37 - column 11 line 11). Thus, Watanabe et al does not teach or suggest reading the second information tag (the responding circuit 4) either prior to or concurrently with reading the first information tag (the bar-code 15).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ackley et al (US 6,371,375 B1), Ohanian et al (US 6,109,526), and Main et al (US 5,216,233) all teach devices for reading first and second information tags.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jared J. Fureman
Art Unit 2876

May 19, 2003